

REMARKS/ARGUMENTS

The Office Action mailed June 16, 2004 has been carefully considered. Reconsideration in view of the following remarks is respectfully requested.

Claim Status and Amendment to the Claims

Claims 1-129 are now pending.

The Applicant gratefully acknowledges the indication of allowance of claims 1-3, 7, 10-13, 23-33, 35-44, and 60-67. The Applicant is further grateful for the indication of allowability of claims 45-53, subject to their re-writing in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4-6, 14-15, 18-22, 34, have been canceled, without prejudice or disclaimer of the subject matter contained therein.

Claims 8, 47-48, 56-57, and 59-60 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention.

New claims 68-129 also particularly point out and distinctly claim subject matter regarded as the invention. New claims 68-76 represent claims 45-53, respectively, rewritten in independent form to include the limitations of independent claim and intervening claims. New claims 77, 78-80, 81-82, and 83-91 are In re Beauregard claims corresponding to method claims

9, 54-56, 16-17, and 45-53, respectively. New claims 92-94, 95-96, and 97-105 are means-plus-function claims corresponding to method claims 54-56, 16-17, and 45-53, respectively. New claims 106-107, 108-110, 111-112, and 113-121 are apparatus claims corresponding to method claims 8-9, 54-56, 16-17, and 45-53, respectively. New claims 122 and 123-125 are In re Beauregard claims corresponding to allowed method claims 3 and 11-13, respectively. New claims 126 and 127-129 are means-plus-function claims corresponding to allowed method claims 3 and 11-13, respectively.

Claim Objections

Claim 56 stands objected to because of minor informalities.¹ With this Amendment it is respectfully submitted the claims satisfy the statutory requirements.

The 35 U.S.C. § 103 Rejection

Claims 8, 9, 16, 17, and 54-59 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sidhu et al.^{2,3} among which claims 8, 59, and 57 are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

¹ Office Action dated June 16, 2004, ¶ 1.

² U.S. Patent No. 5,150,464.

³ Office Action ¶ 6.

combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.⁴

Claim 8

Claim 8 recites:

A method for detecting a path to a first network device, said method comprising:
initializing a hop count;
setting a first destination Ethernet address field to be equal to the Ethernet address of the first network device;
setting a first source Ethernet address field to be equal to the Ethernet address of a second network device;
transmitting from the second network device a data packet containing the hop count, the first destination Ethernet address, and the first source Ethernet address to adjacent network devices;
receiving at the second network device a reply data packet containing a second destination Ethernet address corresponding to the Ethernet address of the second network device and a second source Ethernet address corresponding to the Ethernet address of one of the adjacent network devices.

The Examiner states the following in its entirety regarding claim 8:

... Sidhu et al. discloses a method for detecting a path to a first network device comprising:
initializing a hop count (initially set, col. 13 lines 38-44);
setting a first destination Ethernet address field to be equal to the Ethernet address of a first network device (col. 7 lines 25-48);
setting a first source Ethernet address field to be equal to the Ethernet address of a second network device (col. 7 lines 25-48);
transmitting (col. 13 lines 28-48) from the second network device a data packet (Fig. 9) containing the hop count, the first destination Ethernet address, and the first source Ethernet address to adjacent network device (Fig. 8 and col. 11 lines 58-68); receiving (col. 13 lines 59-68) at the second network device a reply data packet containing a second destination Ethernet address corresponding to the Ethernet address of the second network device and a second source Ethernet address corresponding to the Ethernet address of one of the adjacent network devices (Fig. 8 and col. 11 lines 58-68).⁵

⁴ M.P.E.P § 2143.

⁵ Office Action ¶ 6.

The Applicant respectfully submits that the Examiner has not indicated the difference(s) between claim 8 and the Sidhu et al. reference. Nor has the Examiner provided a suggestion or motivation to combine the reference teachings in the prior art to modify the teachings of Sidhu et al. to the claimed invention. For this reason, the rejection under 35 U.S.C. § 103 is unsupported by the art and should be withdrawn.

Additionally, Sidhu et al. does not teach or suggest all claim limitations. As indicated previously, claim 8 requires setting a first destination Ethernet address field to be equal to the Ethernet address of a first network device, setting a first source Ethernet address field to be equal to the Ethernet address of a second network device, transmitting from the second network device a data packet containing the hop count, the first destination Ethernet address, and the first source Ethernet address to adjacent network devices, and receiving at the second network device a reply data packet containing a second destination Ethernet address corresponding to the Ethernet address of the second network device and a second source Ethernet address corresponding to the Ethernet address of one of the adjacent network devices. Thus, the network device that transmits the data packet containing the hop count is the same device that receives the reply data packet. And both the source Ethernet address in the transmitted data packet and the destination Ethernet address in the reply data packet are the Ethernet address of the network device that transmits the data packet containing the hop count and receives the reply data packet. Also, the destination address in the data packet containing the hop count need not be the same as the destination address in the reply data packet.

In support of the Examiner's contention regarding the receiving step of claim 8, the Examiner points to portions of Sidhu et al. that illustrate adjacent network nodes (FIG. 8 and FIG. 9 of Sidhu et al.) and calculating a checksum of data in a received packet to determine whether a datagram was damaged in transit.⁶ But nowhere does Sidhu et al. disclose or suggest the receiving step as required by claim 8. The Examiner is reminded that the mere absence from a reference of an explicit requirement of a claim cannot be reasonably construed as an affirmative statement that the requirement is in the reference.⁷

For the above reasons, the 35 U.S.C. § 103 rejection is unsupported by the art. Thus, no prima facie case of obviousness has been established and the 35 U.S.C. § 103 rejection should be withdrawn.

Claims 57 and 59

Claims 57 and 59 include limitations similar to claim 8. Claim 8 being allowable, claims 57 and 59 must be allowable for at least the same reasons.

Dependent Claims

Claims 9, 16-17, and 54-56 depend from claim 8. Claim 58 depends from claim 57. The base claims being allowable, the dependent claims must be allowable for at least the same reasons.

⁶ Sidhu et al. col. 13 lines 59-68.

⁷ *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987).

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

Allowable Subject Matter

The Examiner is thanked for the allowance of claims 1-3, 7, 10-13, 23-33, 35-44, and 60-67, and for the finding of allowable subject matter in claims 45-53 if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 68-76 represent claims 45-53, respectively, rewritten in independent form to include the limitations of independent claim and intervening claims. The Applicant acknowledges the Examiner's statement of reasons for allowance as set forth in the Office Action. However, the Applicant points out that the reasons for allowability of the above referenced claims are not limited to the reasons for allowance as set forth in the Office Action, and that additional reasons for allowability may exist, each of which may be independently sufficient to establish the patentability of one or more pending claims.

The Applicant respectfully reserves the right to introduce, articulate, or otherwise comment on any such additional reasons for allowance as may be appropriate in any future proceedings concerning the claimed invention.

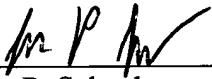
If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

The Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

Dated: September 16, 2004



John P. Schaub
Reg. No. 42,125

Thelen Reid & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
Tel. (408) 292-5800
Fax. (408) 287-8040